

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 35

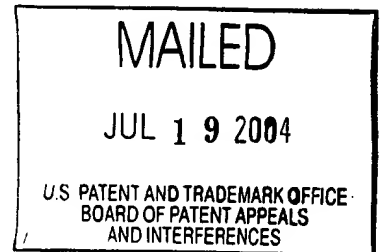
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN F. LINDER and CRAIG H. MALLERY

Appeal No. 2003-0962
Application 08/878,978

ON BRIEF



Before FLEMING, RUGGIERO, and MACDONALD, Administrative Patent Judges.

MACDONALD, Administrative Patent Judge.

REMAND TO THE EXAMINER

We remand this application to the Examiner for consideration of the following matters.

- I. The rejection of claims 1-5, 8, and 9 under 35 U.S.C. § 112, first paragraph.
- II. The definitions of "parse" and "categorize."

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I. The Rejection of Claims 1-5, 8, and 9 Under 35 U.S.C. § 112.

In the final rejection¹ the Examiner rejected claims 1-5, 8, and 9 under 35 U.S.C. § 112, first paragraph.

The appeal brief² before us does not mention nor address this rejection in any way. Appellants' brief is required to be responsive to every grounds of rejection stated by the Examiner. See 37 CFR § 1.192 (c) (3) and (6). Therefore, we request that the Examiner comply with the instructions of MPEP § 1206, as follows:

Where an appeal brief fails to address any ground of rejection, appellant shall be notified by the examiner that he or she must correct the defect by filing a brief (in triplicate) in compliance with 37 CFR 1.192(c). See 37 CFR 1.192(d). Form paragraphs 12.76-12.76.06 and 12.78, or form PTOL-462, "Notification of Non-Compliance with 37 CFR 1.192(c)," may be used to notify the appellant of the deficiency.

Accordingly, we *remand* for consideration of this issue.

¹ Paper number 22.

² Paper number 29, which replaces paper number 26.

II. The definitions of "parse" and "categorize."

In the final rejection under 35 U.S.C. § 103 the Examiner points to the "categorizing" at column 5, line 25, of the Ueda et al. patent to show the "parsing" of claim 1. At no point does the Examiner compare the definitions of these two words and explain why the term "categorizing" is deemed to meet the claimed "parsing."

Upon our review of Appellants' specification, we fail to find any definition of the term "parse" that is different from the ordinary meaning. We find the ordinary meaning of the term "parse" is best found in the dictionary. We note that the definition most suitable for "parse" is "to separate into more easily processed components".³ Similarly, the ordinary meaning of the term "categorize" is best found in the dictionary. We note that the definition most suitable for "categorize" is "to assign to categories."⁴

Therefore, we request that the Examiner compare the definitions of these two words and explain why the term "categorizing" is deemed to meet the claimed "parsing."

³ Dictionary.reference.com, 2004. Copy provided to Appellant.

⁴ Dictionary.reference.com, 2004. Copy provided to Appellant.

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Accordingly, we *remand* for consideration of this issue.

Conclusion

If reconsideration by the examiner does not promptly result in the withdrawal of all pending rejections, the examiner must return this application to the jurisdiction of the Board so that the appeal may be restored to its existing place in the order in which appeals are decided. In the event that the examiner returns this application to the jurisdiction of the Board following reconsideration a new appeal number will be assigned. However, a new appeal fee will not be required.


This application, by virtue of its Special status, requires *immediate* action by the examiner. See MPEP § 708.01(d). The Board of Patent Appeals and Interferences *must* be informed

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promptly of any action affecting the appeal in this case,
including reopening of prosecution, allowance and/or abandonment
of the application.

REMAND


MICHAEL R. FLEMING)
Administrative Patent Judge)


JOSEPH F. RUGGIERO)
Administrative Patent Judge)


ALLEN R. MACDONALD)
Administrative Patent Judge)

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